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TRADEMARK  
4018-0109T

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

APPLICANT: CHARTER MEDICAL, LTD.  
APPL. NO.: 76/148,781  
FILED: October 17, 2000  
MARK: "TRU-FLO"  
CLASS: Intl. Class 10  
LAW OFFICE: 105

**TTAB**

AMENDMENT

Commissioner of Trademarks  
P.O. Box 1451  
Alexandria, Virginia 22313-1451

October 23, 2006

Sir:

The present application has been refused registration by the Trademark Attorney based on U.S. Registration No. 2,764,789. A Consent to Use and Register Agreement has been reached by the Applicant and the owner of the cited registered mark, namely, Smiths Medical, Inc. A copy of this Agreement is enclosed for the review of the Trademark Attorney.

According to the Agreement between the Applicant and Smiths Medical, Inc., the following Amendment is respectfully made to the present application.



10-23-2006

U.S. Patent & TMO/TM Mail Rcpt Dt. #34

IN THE APPLICATION

Delete the entire Identification of goods and substitute with the following:

--Neonatal intravenous infusion sets, namely blood administration  
sets used exclusively for neonatal blood transfusions, in  
International Class 10.--

REMARKS

According to the Consent to Use and Register Agreement between Charter Medical, Ltd. and Smiths Medical, Inc., Applicant has amended the Identification of Goods in the present application as follows:

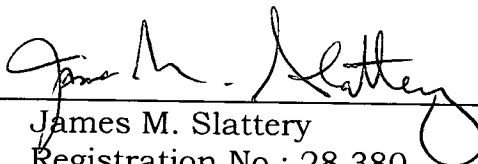
--Neonatal intravenous infusion sets, namely blood administration sets used exclusively for neonatal blood transfusions, in International Class 10.--

Entry of the amended Identification of Goods into the application is respectfully requested. Since the amended Identification of Goods only narrows the scope of the Identification of Goods, it should be accepted by the Trademark Examining Attorney. If the Trademark Attorney has any question in this regard, he or she is welcome to call the undersigned at (703) 205-8000.

Due to the Agreement and the Amendment, the Trademark Attorney is respectfully requested to withdraw the refusal to register the present application based on U.S. Registration No. 2,764,789. The present application should be approved for publication. An early Notice of Publication is respectfully requested.

Please charge any fees or credit any overpayment pursuant to 37 C.F.R. § 2.6 to Deposit Account No. 02-2448.

Respectfully submitted,  
BIRCH, STEWART, KOLASCH & BIRCH, LLP

By:   
James M. Slattery  
Registration No.: 28,380  
P.O. Box 747  
Falls Church, Virginia 22040-0747  
(703) 205-8000

**CONSENT TO USE AND REGISTER AGREEMENT**

THIS AGREEMENT, effective as of the last date set forth below, is entered into between CHARTER MEDICAL, LTD., a North Carolina corporation, whose business address is 3948-A West Point Boulevard, Winston-Salem, North Carolina 27103 (hereinafter "CHARTER MEDICAL"), and SMITHS MEDICAL MD., INC., whose business address is 1265 Grey Fox Road, St. Paul, Minnesota 55112 (hereinafter "SMITHS MEDICAL").

WHEREAS, CHARTER MEDICAL is the owner of expired U.S. Trademark Registration No. 1,083,880 for the mark "TRU-FLO" registered in the U. S. Patent and Trademark Office on January 31, 1978, in connection with intravenous infusion sets, in International Class 10. The mark was first used anywhere in the world and in commerce at least as early as September 19, 1975. Although this registered mark was cancelled for failure to file a renewal application, Charter Medical claims the mark has been continuously used by CHARTER MEDICAL and through its predecessors in interest in such commerce.

WHEREAS, CHARTER MEDICAL is also the owner of a U.S. Trademark Application No. 76/148,781 for the mark "TRU-FLO" filed in the U. S. Patent and Trademark Office on October 17, 2000, in connection with intravenous infusion sets, in International Class 10. The Trademark Examiner refused to register this application based on U. S. Registration No. 2,764,789 for the mark "TRUFLOW" registered in the U. S. Patent and Trademark Office on September 16, 2003, in connection with hemodialysis catheters. SMITHS MEDICAL is now the owner of U. S. Registration No. 2,764,789.

WHEREAS, SMITHS MEDICAL is the owner of U.S. Registration No. 2,764,789 for the mark "TRUFLOW" for hemodialysis catheters, which recites a date of first use at least as early as April 29, 2003.

NOW, THEREFORE, in consideration of the foregoing facts, the parties wish to resolve the controversy and agree as follows:

1. CHARTER MEDICAL will use and register the mark "TRU-FLO" on the amended goods, "neonatal intravenous infusion sets, namely blood administration sets used exclusively for neonatal blood transfusions," and will not use, register or attempt to register the mark "TRU-FLO" or variation thereof for hemodialysis catheters.

2. CHARTER MEDICAL will file an Amendment to amend the goods in U.S. Application No. 76/148,781 as set forth in paragraph 1 above.

3. SMITHS MEDICAL will use the registered mark "TRUFLOW" in conjunction with hemodialysis catheters and will not use, register or attempt to register the mark "TRUFLOW" or variations thereof for neonatal intravenous infusion sets, namely, blood administration sets used exclusively for neonatal blood transfusions.

4. CHARTER MEDICAL hereby acknowledges SMITHS MEDICAL's rights in the mark "TRUFLOW" and will not challenge SMITHS MEDICAL's use and registration of "TRUFLOW" on the goods set forth in Registration No. 2,764,789, so long as SMITHS MEDICAL is in compliance with this Agreement.

5. SMITHS MEDICAL hereby acknowledges CHARTER MEDICAL's rights in the mark "TRU-FLO" and will not challenge the use and registration of the mark "TRU-FLO" on "neonatal intravenous infusion sets, namely blood administration sets used exclusively for neonatal blood transfusions," so long as CHARTER MEDICAL is in compliance with this Agreement.

6. This Agreement will be binding upon CHARTER MEDICAL and SMITHS MEDICAL, their successors and assigns, and upon individuals and entities acting under their direction, or in privity therewith as long as CHARTER MEDICAL and SMITHS MEDICAL use their respective marks.

7. The parties recognize and acknowledge that so long as their respective marks are used as set forth above, no consumer confusion is likely to result from the concurrent use of their marks. The parties agree to take further steps as may be reasonable and necessary to assure that no such confusion results.

8. This Agreement is the sole and entire Agreement between the parties relating to the subject matter hereof, and supersedes all prior understandings, agreements and documentation relating to such subject matter; and any modifications to this Agreement must be in writing and signed by both parties.

9. Any dispute, controversy or claim arising under, out of or relating to this contract and any subsequent amendments of this contract, including, without limitation, its formation, validity, binding effect, interpretation, performance, breach or termination, as well as noncontractual claims, shall be referred to and finally determined by arbitration in accordance with the American Arbitration Rules. The

arbitral tribunal shall consist of three arbitrators, one selected by each party and a third selected by the American Arbitration Association. The place of arbitration shall be in North Carolina. The dispute, controversy or claim shall be decided in accordance with the laws of North Carolina.

10. If any provision in this Agreement is held by the arbitration to be invalid, void or unenforceable, the remaining provisions will continue in full force without being impaired or invalidated in any way.

11. This Agreement will be governed by U.S. Trademark Law and the laws of North Carolina.

12. This Agreement does not create any agency or partnership relationship.

13. This Agreement is not assignable by either party without the prior written consent of the other party, except that this Agreement may be freely assigned by either party to a company acquiring the assets, including goodwill associated with the marks as identified in the application and registration numbers listed above.

14. This Agreement and any counterpart original thereof and any Notices hereunder may, except as otherwise provided herein, be executed and transmitted by facsimile followed by mailing of the original. The facsimile signature shall be valid and acceptable for all purposes as if it were an original.

IN WITNESS WHEREOF, the undersigned have caused this Agreement to be executed in duplicate by individuals authorized to act on behalf of the parties.

CHARTER MEDICAL, LTD.

By: Mary A. Tremblay

Typed Name: Mary A. Tremblay

Title: Vice President, General Counsel & Secy.

Dated: 7/14/06, 2006

SMITHS MEDICAL, INC.

By: James R. Stitt

Typed Name: James R. Stitt

Title: PRESIDENT

Dated: 9-1-06, 2006



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**LETTER**

Commissioner of Trademarks  
P.O. Box 1451  
Alexandria, Virginia 22313-1451

October 23, 2006

Sir:

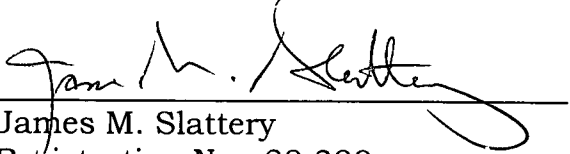
Procedurally, an Appeal Brief is due on October 23, 2006. Due to the filing of an Amendment together with a Consent to Use and Register Agreement in connection with the above-identified application in the U.S. Patent & Trademark Office on even date, it is respectfully requested that jurisdiction in connection with the present application should be returned to the Trademark Attorney for further action. At this time, it is respectfully submitted that it would not be necessary to file an Appeal Brief today. If an Appeal Brief is deemed to be necessary, the present letter should be regarded as a Request for an additional extension of time in which to file an Appeal Brief.

Please charge any fees or credit any overpayment pursuant to 37 C.F.R. §  
2.6 to Deposit Account No. 02-2448.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By: \_\_\_\_\_

  
James M. Slattery

Registration No.: 28,380

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JMS/BG/adt